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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/515,948 02/29/00 HENRY

R ACD-2-0016-1

EXAMINER

IM52/0522

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ART UNIT

PAPER NUMBER

1714

DATE MAILED:

05/22/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/515,948

Applicant(s)

Henry

Examiner

T. Yoon

Group Art. Unit

1714

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 5-7-01
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-30 is/are pending in the application.
- Of the above claim(s) 12-14 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-4, 7-9, 15-23, 25-29 is/are rejected.
- ☒ Claim(s) 5, 6, 10, 11, 24, 30 is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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### DETAILED ACTION

This is C-I-P filed on February 29, 2000, and contains new matter, reactive VOC solvents, which was not disclosed in the parent case 09/022,779, now US Pat. 6,048,471. Therefore, US Pat. 6,187,736 filed on March 11, 1998 is a valid prior art.

Applicant's election of Claims 1-11 and 15-30 without traverse is acknowledged.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4, 8, 17, 19, 23 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited "naphthenic" in claims 1, 19, 23 and 25 is incorrect, and should be "naphthenic". Also, "(13) nitroparaffins" in claim 23 should be "nitroparaffins".

Improper Markush language is recited in claims 4 and 8, and proper format is "--- selected from the group consisting of ---".

The recited "---one resin ---of styrene-butadiene, polychloroprene, polyvinyl chloride, acrylic, epoxy, urethane, nitrocellulose, and styrene" in claims 4 and 17 is confusing since it lacks consistency. The preamble recites "resin" which means a polymer, but the recited species are

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monomers such as styrene-butadiene or styrene and polymers such as polychloroprene or polyvinyl chloride. Corrections are needed.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23, 26 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Jarema (US 6,187,736).

Jarema teaches solvent mixtures containing *t*-butyl acetate at cols. 3 & 4 and in table 1.

Thus, the instant invention lacks novelty.

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Claims 1-3 and 15-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Sato et al (US 5,753,727).

Sato et al teach the instant compositions in table 1. A mixing of solvents meets the instantly claimed mixing since % by volume of one solvent is changed by mixing other solvent(s).

Thus, the instant invention lacks novelty.

Claims 1-4, 7-9, 15-23 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al (US 5,753,727) in view of Jarema (US 6,187,736) or Ochiai et al (US 5,916,713).

The instant invention further recites *t*-butylacetate over Sato et al who teach various ester solvents such as ethyl acetate, butyl acetate and the like at col. 4, lines 21-22. Jarema teaches *t*-butyl acetate as a solvent, and Ochiai et al teach various solvents such as (n, sec, t)-butylacetate at col. 14, line 16.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize *t*-butyl acetate of Jarema or Ochiai et al in Sato et al as an ester solvent since Sato et al teach various ester solvents which is well known in the art as evidenced by Jarema and Ochiai et al.

Claims 1-3 and 15-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Mori et al (US 5,252,668).

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Mori et al teach the instant compositions in table 1. Various amounts of the solvent is claimed in claim 3.

Thus, the instant invention lacks novelty.


Claims 5, 6, 10, 11, 24 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Also, claim 25 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action and if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

THY/May 18, 2001

  
TAE H. YOON  
PRIMARY EXAMINER